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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,803	02/24/1999	NATHALIE EL KHIATI	3633-462	1528

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EXAMINER

SAMPLE, DAVID R

ART UNIT PAPER NUMBER

1755

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/242,803

Applicant(s)

EL KHIATI ET AL.

Examiner

David Sample

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,20 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19,20 and 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 19, 20, and 23-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Siedel et al. (US Patent No. 5,990,023).

It appears that the applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Siedel et al. discloses glasses that have a thermal stress factor of 0.69 and 0.76 N/(mm²•K), and transformation points of 1061 and 1190°C. See col. 4, lines 7-12 and col. 5, lines 2-8. The "transformation point" is the temperature where the glass has a viscosity of 10⁴ dPa•s. See col. 3, lines 27-28. This definition is identical to the definition of "working temperature" recited in the specification. See page 6, lines 25-26 of the instant specification. Thus, Siedel et al. discloses a glass having a working temperature of less than 1200°C. The reference discloses glasses having a thermal expansion of 7.6x10⁻⁶K⁻¹ and 7.9x10⁻⁶ K⁻¹ at col. 4, lines 7-8 and col. 5, lines 3-4.

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As to claim 20, Siedel et al. discloses glasses having softening temperatures of 761 and 800°C. See col. 4, lines 7-12 and col. 5, lines 2-8.

As to the strain points recited in claims 19 and 23, the reference fails to disclose a strain point associated with the disclosed glasses. However, a glass' composition determines its viscosity characteristics upon heating. The glass disclosed by Siedel et al. is identical to the glass described by instant claims 25-28. See col. 4, lines 65-67. Therefore, because the glass of Siedel is identical to the presently claimed glass, the glass of Siedel et al. is assumed to inherently possess the recited strain points. See MPEP 2112.

As to the remainder of claim 23, Siedel et al. discloses a glass having working point of 1061 and 1190°C, and a thermal expansion coefficient of 7.9×10^{-6} /K. See col. 4, lines 7-12, col. 5, lines 3-9. These properties fall within the ranges recited in instant claim 23. The reference discloses that the glass has a softening point of 750 to 830°C. See col. 5, lines 37-38. This range is sufficiently specific to anticipate the range recited in instant claim 23. See MPEP 2131.03.

As to claim 24, the reference fails to disclose the recited values of $\phi^2 \cdot c/a$. However, the value of the recited property for a glass is dependent upon the glass composition, and the how the glass is made. The glass recited by Siedel et al. has a glass composition that is identical to the glass recited in instant claims 19 and 25-28. See col. 4, lines 65-67. Moreover, the glass is made in a manner that is identical to the method applicants' employ in forming their glass. In particular, the glass is melted, formed, and thermally toughened. See col. 3, lines 66 to col. 4 line 27, and col. 5, lines 10-15 of Siedel et al. and page 16, lines 1-12 of the specification. Accordingly, the property of " $\phi^2 \cdot c/a$ " recited in instant claim 24 is assumed to be inherent to the

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glass of Siedel et al. because the glass of Siedel et al. has the same composition and is made in the same manner. See MPEP 2112.

The glass composition disclosed by Siedel et al. at column 4, lines 65-67 has amounts of components that fall within the ranges of components recited in instant claims 19 and 25-28. As to claim 28, it is noted that the claim recites a lower limit for SrO of 3 wt% whereas the reference discloses 2.5 wt% SrO. However, the SrO content in claim 28 is claimed in one significant figure. The amount of SrO disclosed by Siedel et al. is recited in two significant figures, i.e., 2.5 wt%. See col. 4, line 66. If the SrO of Siedel et al. were recited as one significant figure, it would be 3 wt%. Thus, the reference discloses a glass having 3 wt% SrO. Therefore, the reference is deemed to anticipate instant claim 28.

As to the ϕ recited in instant claim 29, the reference discloses a glass that has a thermal stress factor of 0.76 N/(mm² K). See col. 5, lines 4-5.

As to the $\log \rho_{(250^\circ)}$ recited in claims 29 and 30, the $\log \rho_{(250^\circ)}$ of a glass is dependent upon its glass composition. The glass of Siedel et al. is identical to the glass recited in instant claims 25-28. See col. 4, lines 65-67. Accordingly, the property of $\log \rho_{(250^\circ)}$ recited in instant claims 29 and 30 is assumed to be inherent to the glass of Siedel et al. because the glass composition of Siedel et al. is identical instantly claimed composition. See MPEP 2112.

As to claims 31 and 32, the reference discloses forming a monolithic glazing pane from the disclosed glass compositions. See col. 3, lines 11-12.

As to claim 33, Example 3, col. 4, of the reference contains the recited amount of SiO₂ + Al₂O₃ + ZrO₂.

Response to Arguments

Applicant's arguments filed April 25, 2003 have been fully considered but they are not persuasive.

Applicants appear to argue that they are entitled to foreign priority because each claim recitation can be found in at least one of the three priority documents. Applicants have not cited any authority for this assertion. The examiner is not aware of any authority that is directly on point. However, the examiner has found Studiengesellschaft Kohle m.b.H v. Shell Oil Co., 10 USPQ2d 1674 (CAFC 1997). In Studiengesellschaft, patentee was attempting to aggregate the disclosure of two separate U.S. applications in order receive priority to the two applications under 35 U.S.C. § 120. The CAFC refused to grant the claim to priority and stated that "Section 120 requires an applicant to meet the disclosure requirement of § 112, paragraph 1 in a single parent application in order to obtain an earlier filing date for individual claims." Id at 1677. The examiner believes that it appropriate to apply the same logic to the present instance, because the requirements of § 120 are the same as § 119 with respect to 112, first paragraph.

Accordingly, the examiner believes that each claim must be supported by a single foreign application to be entitled to the effective filing date of the foreign application, and applicants are not entitled to foreign priority for the reasons stated in the previous action.

Applicants' assert that the examiner cannot maintain that the claimed strain point and viscosity characteristics are inherent to the reference glass. Applicants note that the examiner deemed it persuasive that the § 1.132 declaration was persuasive in overcoming the rejection over Koch et al. The rejection of Koch et al. is distinguishable from the rejection over Seidel et al. The rejection over Koch et al. was based upon the obviousness of ranges, and the assertion

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that because of the overlapping range, one of ordinary skill in the art would expect that the glass of Koch et al. would have the claimed properties. This assertion was easily overcome with the § 1.132 declaration, which showed that a composition having amounts of components outside the ranges of instant claims 25 does not have the claimed properties.

In contrast, Seidel et al. discloses a composition that falls squarely within the presently claimed ranges. See col. 4, lines 66-67. Identical compositions cannot have mutually exclusive properties. See MPEP 2112.01.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (703)308-3825. The examiner can normally be reached on Monday to Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703)308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.


David Sample
Primary Examiner
Art Unit 1755

DRS
July 9, 2003